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EXAMINER	
ASINOVSKY, OLGA	
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SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
2 MONTHS	04/25/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 2 MONTHS from 04/25/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/018,336
Filing Date: October 30, 2001
Appellant(s): LETTMANN, BERNHARD

Mary E. Golota
For Appellant

Supplemental EXAMINER'S ANSWER

Pursuant to the remand under 37 CFR 41.50(a)(1) by the Board of Patent Appeals and Interferences on September 29, 2006 **for further consideration of a**

rejection, a supplemental Examiner's Answer under 37 CFR 41.50(a)(2) is set forth below:

The reply brief filed April 04, 2007 has been entered and considered. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

The supplemental examiner's answer responding to the reply brief is without raising any new grounds of rejection. The supplemental examiner's answer is supporting the rejection set forth in the examiner's answer mailed on August 23, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the reply brief is correct.

This appeal involves claims 3, 18-19, 21-22, 25-26 and 28.

Claims 12-13 and 29-32 were withdrawn from consideration as not directed to the elected invention.

Claims 1, 2, 4-11, 14-17, 20, 23-24, 27, 33-41 have been canceled.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the reply brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: There is no rejection of claims 3, 18-19, 21-22, 25-26 and 28 under 35 U.S.C. 103(a) as being obvious over Reusmann et al U.S. Patent 6,403,701. There is no separate paragraph of the rejection of the pending claims over Reusmann individually.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,403,701	Reusmann et al.,	June 11, 2002
EP 0 081 994	Kawakami et al.	June 22, 1983

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3, 18-19, 21-22, 25-26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reusmann et al. U.S. Patent 6,403,701 in view of Kawakami et al. EP 0 081 994.

Independent claim 3 and dependent claims 18-19, 21-22, 25-26 and 28 discloses a process for preparing an aqueous coating material with precisely defined shade and optical effect comprising mixing modules different in material composition and functional and stored separately from one another, shortly before application of the coating material, wherein the modules comprise: (I) at least one module containing less than 5% by weight water and said module provides at least one of color and effect comprising at least one binder (a11), at least one pigment (a12) and at least one organic solvent to form a base color (A1); (II) at least one aqueous color module comprising at least one water-soluble or –dispersible binder (a21), at least one color pigment (a22) and water (a23) to form at least one aqueous color-imparting base color (A2); and (III) at least one pigment-free mixing varnish module comprising (B) at least one aqueous, pigment-free mixing varnish comprising (b1) at least one water-soluble or –dispersible binder, and (b2) water; and optionally at least one rheology control additive (C). In other words, the claimed process for preparing an aqueous coating material comprises step of preparing modules (I), (II) and (III) which are stored separately and mixing said modules (I), (II) and (III) shortly before application.

Claim 3 and their dependent claims are stand together.

Reusmann discloses a process for preparing water-dilutable coating compositions with precisely defined tinting, comprising the steps of: preparing a plurality of base colors; separately storing each of said base colors, and mixing, shortly before application of the coating composition, columns 17-18, claim 12, for the present claimed process in claim 3. The water-dilutable coating compositions comprises a plurality of base colors (A) and at least one pigment-free component (B), and at least one rheology-controlling additive, column 17, lines 1-6, 29-30 and 31-32. The base colors (A) comprise less than 5% by weight of water, at least one pigment, an organic solvent, and at least one water-dilutable first binder. The component (B) comprises a pigment-free an aqueous dispersion of polyurethane resin=second binder, column 3, lines 1-3 and claim 1 at column 17, lines 5-17. The component (A) is readable for being claimed (A-1) base color in the claimed module (I), in the present claim 3. The component (B) is readable for being claimed aqueous, pigment-free varnish module (III), in the present claim 3. The first binder (A) and the second binder in the component (B) can be the same binder, column 13, lines 25-26; column 4, lines 52-55 and column 9, lines 7-12. The polyurethane resins as binders are readable in the present claims 25-26. A rheology additive is readable for being the optionally claimed component (C) in the present claim 3 and 21-22. The polyurethane resins can be prepared from an isocyanate-functional prepolymer wherein said functional group is capable of forming anions, column 6, lines 10-14 and 37-41; column 7, lines 14-20 and column 11, lines 18-33, for the present claim 28. Suitable groups capable of forming anions are carboxyl groups, column 7, lines 57-58, for the present claim 28. The coating composition

comprises a plurality of base colors (A). The base colors (A) comprise a combination of at least one organic coloring pigment and at least one inorganic coloring pigment, column 12, lines 56-59 and column 3, lines 7-35, for the present claim 18. Suitable special-effect pigments at column 3, lines 18-28 is also can be present, for the present claim 19. The coloring pigments and special-effect pigments are readable in claimed (A1) to form module (I) in the present claim 3. The solvents are water-soluble or water-thinnable solvents such as alcohols, column 4, lines 61-62, for the present claim 3. Reference discloses a process for preparing components (A) and (B), and directly after their preparation by mixing the components (A) and (B), the coating compositions are applied to the substrate, column 13, lines 43-55. The coating compositions can be applied by spraying on various substrates, wherein the substrates include metal, wood, plastic or paper, column 13, line 43 through column 14, line 17. The base colors compositions (A) can be mixed with a suitable amount of the aqueous component (B). Reusmann discloses a formulation of a water-dilutable coating composition, which can be deluted with water, with or without prior partial removal of the organic solvent employed in the preparing resin, column 11, lines 30-32; column 12, lines 1-7 and column 13, lines 7-17.

The difference between the present claims and Reusmann invention is that Reusmann does not disclose a (A-2) component of an aqueous coating composition comprising a color-imparting pigment, binder and water.

Kawakami discloses compositions for an aqueous coating a paper. A composition includes a conventional pigment, binder and water, abstract and page 1, line 1; page 2, lines 30-32; page 3, lines 1-8; page 8, lines 13, 23-24 and 29-32.

Both references disclose an aqueous coating composition comprising a colorant such as for example, titanium dioxide, binder and water. Both references disclose the same utility of using an aqueous coating composition for coating a paper substrate.

It would have been obvious to one of ordinary skill in the art to modify the aqueous coating composition in Reusmann invention by incorporating the composition of Kawakami in order to impart enhanced water resistance and desired solids content and physical properties of coating composition, because the addition composition based on binder, conventional pigment and water could be expected in Reusmann invention for obtaining the desired coating color and the desired solid content with the intended use of the aqueous coating composition in Reusmann at column 13, lines 11-17, and because a color-imparting pigment is present in the resulting aqueous coating composition in Reusmann invention.

(10) Response to Argument

The examiner would like to note that appellants do not traverse the Examiner's position that the aqueous coating composition in Reusmann invention comprises a plurality of base colors (A) comprising color-effect pigment and coloring pigment, organic solvent and binder; and a pigment-free component (B) comprising a binder and

water wherein a binder can be the same binder. Also, appellants do not argue that the amount of binder, water, solvent and solid content of pigments can be varied depending on the intended use of the aqueous coating composition.

Appellants' argument is that the Examiner's Answer of August 23, 2005 contains a new ground of rejection of the pending claims over Reusmann et al U.S. Patent 6,403,701 as taken individually reference.

There is no rejection of claims 3, 18-19, 21-22, 25-26 and 28 under 35 U.S.C. 103(a) as being obvious over Reusmann et al U.S. Patent 6,403,701. There is no separate paragraph of the rejection of the pending claims over Reusmann individually. There is no new ground of rejection.

Appellants' argument is that independent claim 3 is nonobvious over Reusmann' 701 in view of Kawakami' 994, because Reusmann fails to disclose all three claimed modules (I), (II) and (III) for coating composition, and there is no motivation to include the paper coating composition of the Kawakami' 994 in the system of the Patent' 701 (page 11 in the appellants' argument). The claimed invention is a process in the independent claim 3, the process requires the combination of an organic solvent based base color (A1), and aqueous base color (A2), and an aqueous pigment-free mixing varnish (B). The argument is that reference to Reusmann'701 fails to disclose the claimed aqueous base color (A2) comprising a binder, color pigment and water. The

cited combination fails to provide any suggestion or motivation to do what appellant has done.

The primary reference to Reusmann discloses water-dilutable coating composition. The coloring pigment is not reactive material. The binder can be the same binder in any compositions A and B and the same binder in any addition composition. Any additional aqueous base having color pigment dispersion would be expected in the aqueous coating composition in Reusmann invention for color-imparting property for obtaining the desired shade of the aqueous coating composition, column 11, lines 64-67.

The secondary reference to Kawakami '994 discloses an aqueous coating composition on to paper substrate. The composition comprises thermosetting resin, conventional pigment, binder and water. Thermosetting resin and binder are readable in the formulation of an aqueous coating composition in the present claims and in Reusmann invention. The aqueous composition in Reusmann invention can be applied on to paper substrate, column 13, line 46.

Both references disclose aqueous coating composition comprising a colorant=pigment, binder and water. Both references disclose the same utility of using an aqueous coating composition for coating a paper substrate. For these reasons it would be obvious to combine the teachings of these two references for modifying an aqueous coating composition in Reusmann by employing a composition of Kawakami invention as addition composition based on binder, conventional pigment and water for obtaining the desired coating color and the desired solid content for a coating

composition. The prima facie case of obviousness is that the addition water containing binder with color pigment is expected in the water-dilutable coating composition Reusmann invention to control the color effect and the desired solid content in the coating composition. Thus, with regards to appellants' position that the cited references fails to provide any motivation to combine the teachings of these references is not persuasive.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

O. A

April 10, 2007

Conferees:

James Seidleck

David Wu

James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700

The appellant must within **TWO MONTHS** from the date of the supplemental examiner's answer exercise one of the following two options to avoid *sua sponte*

dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding:

(1) **Reopen prosecution.** Request that prosecution be reopened before the examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit, or other evidence. Any amendment, affidavit, or other evidence must be relevant to the issues set forth in the remand or raised in the supplemental examiner's answer. Any request that prosecution be reopened will be treated as a request to withdraw the appeal. See 37 CFR 41.50(a)(2)(i).

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. If such a reply brief is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened under 37 CFR 41.50(a)(2)(i). See 37 CFR 41.50(a)(2)(ii).

Extensions of time under 37 CFR 1.136(a) are not applicable to the **TWO MONTH** time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

A Technology Center Director or designee has approved this supplemental examiner's answer by signing below:

James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700

WILLIAM GARY JONES
DIRECTOR
TECHNOLOGY CENTER 1700